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APPLICATION NO.	FILING DATE	FIRST-NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,578	11/30/2000	Peter Bishop	ELX-64	4338

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EXAMINER

W. GUYEN, LEE

ART UNIT	PAPER NUMBER
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2682

DATE MAILED: 11/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/728,578

Applicant(s)

BISHOP ET AL.

Examiner

LEE NGUYEN

Art Unit

2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-16, 21-23 and 25-29 is/are rejected.
- 7) ☒ Claim(s) 11, 17-20, 24 and 30-33 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Schwartz et al. (US 5,894,597).

Regarding claim 1, Schwartz teaches a card reader (fig. 1), comprising: a housing 102; a first set of electrical contacts 106 (fig. 2 and col. 5, line 16) carried upon the housing 102; a second set of electrical contacts 416 (fig. 4, col. 4, lines 59-60) carried upon the housing; a first card holder slide assembly 110 (fig. 1) adapted to receive a first electronic card 108; and a second card holder slide assembly 104 adapted to receive a second electronic card 101; and said housing 102 in communication with both said first card holder slide assembly and said second card holder slide

assembly (the card reader 102 is used to read both SIM 101 and SIM 108 (col. 2, lines 15-30).

Regarding claim 2, Schwartz also teaches that the first electronic card comprises a subscriber identity module (SIM) card (col. 2, line 31).

Regarding claim 3, Schwartz also teaches that both the first and second electronic cards comprise subscriber identity module (SIM) cards (col. 2, lines 31-32).

Regarding claim 10, Schwartz teaches an electronic card reader (fig. 1) for a mobile communications device, comprising: a housing 102; an electrical assembly, the assembly comprising a first set of electrical contacts 106 (fig. 2) and a second set of electrical contacts 416 (fig. 4) carried upon the housing, further wherein said electrical contacts are adapted for flexible engagement (fig. 4); a first card holder slide assembly 110 (fig. 1) adapted to receive a first subscriber identity module (SIM) electronic card 108; a second card holder slide assembly 104 adapted to receive a second subscriber identity module (SIM) electronic card 101; wherein the first set of electrical contacts engage the first SIM card and the second set of electrical contacts engage the second SIM card (col. 2, lines 31-32).

3. Claims 1-5, 9-10 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Tayloe (US 5,987,325) submitted by Applicant.

Regarding claims 1 and 10, Tayloe teaches a card reader (fig. 1), comprising: a housing 101 (fig. 2); inherently a first set of electrical contacts in SIM CARD READER 107 (fig. 2) carried upon the housing; inherently a second set of electrical contacts 107 in SIM CARD READER 107 (fig. 2) carried upon the housing; a first card holder slide assembly 107 (figs. 1-2) adapted to receive a first electronic card 105; and a second card holder slide assembly 107 (figs. 1-2) adapted to receive a second electronic card 105; and said housing 102 in communication with both said first card holder slide assembly and said second card holder slide assembly (col. 3, lines 51-60, col. 4, lines 26-28).

Regarding claim 2, Tayloe also teaches that the first electronic card comprises a subscriber identity module (SIM) card (col. 4, line 26).

Regarding claim 3, Tayloe also teaches that both the first and second electronic cards comprise subscriber identity module (SIM) cards (col. 4, line 26).

Regarding claim 4, Tayloe also teaches that the first and second electronic cards 105 are substantially the same size (fig. 1).

Regarding claim 5, Tayloe also teaches that the first set of electrical contacts and the second set of electrical contacts 107 are carried upon a common electrical assembly 101, 117 (fig. 2).

Regarding claim 9, Tayloe also teaches that the reader operates in a cellular phone (fig. 1 of Tayloe).

Regarding claim 12, Tayloe also teaches the SIM cards are substantially rectangular in shape (fig. 1, 105).

4. Claims 1-10, 12-16, 21-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Bricaud et al. (WO 00/17806) submitted by Applicant.

Regarding claims 1 and 10, Bricaud teaches a card reader (fig. 37), comprising: a housing 50; a first set of electrical contacts 100 carried upon the housing; a second set of electrical contacts 146 in carried upon the housing; a first card holder slide assembly 152 adapted to receive a first electronic SIM card 56 (col. 19, line 24); and a second card holder slide assembly 154 adapted to receive a second electronic SIM card 58 (col. 19,

line 29); and said housing 50 in communication with both said first card holder slide assembly and said second card holder slide assembly (abstract).

Regarding claim 2, Bricaud also teaches that the first electronic card comprises a subscriber identity module (SIM) card (col. 2, line 5 and lines 18-19).

Regarding claim 3, Bricaud inherently teaches that both the first and second electronic cards comprise subscriber identity module (SIM) cards (col. 2, lines 18-24 and line 5).

Regarding claim 4, Bricaud also teaches that the first and second electronic cards 105 are substantially the same size (col. 4, lines 4-5).

Regarding claim 5, Bricaud also teaches that the first set of electrical contacts and the second set of electrical contacts 56, 58 are carried upon a common electrical assembly 54 (fig. 35).

Regarding claim 6, Bricaud teaches contact elements which are constructed by elongated elements 100, 146 (fig. 25).

Regarding claim 7, Bricaud also teaches that the elongated contact elements further comprise curved, resilient contact tips adapted for

electrical communication with said electronic cards (see fig. 25, numerals 100, 146).

Regarding claim 8, Bricaud also teaches that the elongated contact elements electrically engage said first and second electronic cards at multiple contact points (fig. 25, numerals 100, 146 of Bricaud).

Regarding claim 9, Bricaud also teaches that the reader operates in a cellular phone (col. 2, lines 25-26).

Regarding claim 12, Bricaud also teaches the SIM cards are substantially rectangular in shape (fig. 35, numerals 56, 58).

Regarding claim 13, Bricaud also teaches that said first and second card holder slide assemblies each comprise a flat base with a plurality of side walls, further wherein the first and second SIM cards each are adapted for placement in a position upon the flat base of the first and second card holder slide assemblies, respectively, such that the SIM cards are oriented substantially between side walls and securely within said holder slide assemblies (see fig. 35).

Regarding claim 14, Bricaud also teaches that at least one card holder slide assembly comprises an aperture window (fig. 36, numeral 58).

Regarding claim 15, Bricaud also teaches that said first set of electrical contacts are elongated and are provided in a substantially parallel arrangement (numeral 100, 146, fig. 25).

Regarding claim 16, Bricaud also teaches that the elongated electrical contacts each comprise a proximal end and a distal end, wherein the distal ends of said elements are curved to facilitate resilient engagement with said SIM cards (100, 146, fig. 25).

Regarding claim 21, the claims is interpreted and rejected for the same reason as set forth in claim 10.

Regarding claim 22, Bricaud also teaches inserting the second SIM card 58 into the second card holder slide assembly 154 to form a second loaded slide assembly; placing the second loaded slide assembly into operative position within the housing 50; and engaging the second set of electrical contacts 146 with the second SIM card 58 (fig. 35).

Regarding claim 23, the claims is interpreted and rejected for the same reason as set forth in claim 10.

Regarding claim 25, the claim is interpreted and rejected for the same reason as set forth in claim 12.

Regarding claim 26, the claim is interpreted and rejected for the same reason as set forth in claim 13.

Regarding claim 27, the claim is interpreted and rejected for the same reason as set forth in claim 14.

Regarding claim 28, the claim is interpreted and rejected for the same reason as set forth in claim 15.

Regarding claim 29, the claim is interpreted and rejected for the same reason as set forth in claim 16.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point

out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 6-9, 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tayloe in view of Bricaud.

Regarding claim 6, Tayloe does not explicitly teach that the electrical contacts comprise elongated contact elements. In the same field of art, Bricaud teaches contact elements are constructed by elongated elements 100, 146 (fig. 25). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Bricaud to the card reader of Tayloe in order to enhance contacting between the cards and the card reader.

Regarding claim 7, Tayloe as modified by Bricaud also teaches that the elongated contact elements further comprise curved, resilient contact tips adapted for electrical communication with said electronic cards (see fig. 25, numerals 100, 146 of Bricaud).

Regarding claim 8, Tayloe as modified by Bricaud also teaches that the elongated contact elements electrically engage said first and second

electronic cards at multiple contact points (fig. 25, numerals 100, 146 of Bricaud).

Regarding claim 9, Tayloe as modified by Bricaud also teaches that the reader operates in a cellular phone (fig. 1 of Tayloe).

Regarding claim 13, Tayloe as modified also teaches that said first and second card holder slide assemblies each comprise a flat base with a plurality of side walls, further wherein the first and second SIM cards each are adapted for placement in a position upon the flat base of the first and second card holder slide assemblies, respectively, such that the SIM cards are oriented substantially between side walls and securely within said holder slide assemblies (see fig. 35 of Bricaud).

Regarding claim 14, Tayloe as modified by Bricaud also teaches that at least one card holder slide assembly comprises an aperture window (fig. 36, numeral 58 of Bricaud).

Regarding claim 15, Tayloe as modified by Bricaud also teaches that said first set of electrical contacts are elongated and are provided in a substantially parallel arrangement (numeral 100, 146, fig. 25 of Bricaud).

Regarding claim 16, Tayloe as modified by Bricaud also teaches that the elongated electrical contacts each comprise a proximal end and a distal

end, wherein the distal ends of said elements are curved to facilitate resilient engagement with said SIM cards (100, 146, fig. 25 of Bricaud).

Response to Arguments

8. Applicant's arguments filed 9/10/2003 have been fully considered but they are not persuasive.

Regarding the rejection of independent claims 1 and 10, Applicant argues that Schwartz only discloses carrying two cards on a single device, but does not disclose electrical communication with both card holder at once, (emphasis added).

The examiner respectfully disagrees. Neither independent claims 1 nor 10 recite the limitation "at once" as argued. Therefore, Schwartz still anticipates the claimed limitation.

The Declaration under 35 U.S.C. 1.131 has overcome the rejection under Lu and Tu reference. However, this Declaration cannot overcome the new reference that applied to the rejection as stated above.

Allowable Subject Matter

9. Claims 11, 17-20, 24, 30-33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claim 11, the prior art of record fails to teach the first and second card holders assembly as claimed.

Regarding claim 17, the prior art of record fails to teach the configuration of the first and second set of electrical contacts as claimed.


Regarding claim 24, the claim is allowable for the same reason as set forth in claim 11.

Regarding claim 30, the claim is allowable for the same reason as set forth in claim 17.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEE NGUYEN whose telephone number is (703)-308-5249. The examiner can normally be reached on 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, VIVIAN CHIN can be reached on (703) 308-6739. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

 11/16/05
LEE NGUYEN
Primary Examiner
Art Unit 2682